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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/983,394	08/05/2002	S. Douglas Falls	5071X002	1379

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MINTZ LEVIN COHN FERRIS GLOVSKY AND POPEO PC  
12010 SUNSET HILLS ROAD  
SUITE 900  
RESTON, VA 20190

EXAMINER
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MCCLELLAN, JAMES S

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 09/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

08/983,394

Applicant(s)

FALLS ET AL.

Examiner

James S. McClellan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 72-132 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 72-132 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 January 1998 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Preliminary Amendment*

1. Applicant's submittal of an amendment on January 20, 2004 was entered, wherein:
  - claims 72-132 are pending;
  - claims 1-71 have been canceled; and
  - claims 72-132 have been added.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 77, 78, and 98-116 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding **claim 77**, line 5, Applicant's use of the limitation "optionally at least one" is vague and indefinite. The Examiner recommends deleting the term "optionally". Clarification is required.

**Claim 98** recites the limitation "the shelf strip" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Regarding **claims 99-116**, line 4, Applicant's use of the limitation "may include" is vague and indefinite. The Examiner recommends deleting the term "may". Clarification is required.

***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claim 121 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

Regarding the first prong, for a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, and natural phenomena) that do not apply, involve, use, or advance the technological arts fails to promote the “progress of science and the useful arts” (i.e., the physical sciences as opposed to the social sciences) and therefore are found to be non-statutory subject matter. For a process, the recited process must somehow apply, involve, use or advance the technological arts.

In the present case, claim 121 fails to apply, involve, use or advance the technological arts because the process steps can be carried out manually without technology.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 72-78, 93-97, 99-114, 117, and 120-125 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5,537,312 (hereinafter "Sekiguchi").

Regarding **claim 72**, Sekiguchi discloses a label (22; see Figure 1) for display shelf (21; see Figure 1) of a business establishment, comprising: information for identifying at least on product (for example, see Figure 10 "Lettuce"), and one or more space indicators (see Figure 9) for the at least one product identified by the information for indicating at least on of a corresponding area of the shelf for arranging the product thereon an a position for the product on the shelf (see Figure 9 and column 8, lines 46-62); [**claim 73**] information includes color (see paragraph bridging columns 8-9), product name (see Figure 9, "Lettuce"), price (see Figure 9, "100 Yen"), and advertisement/promotion (see Figure 10, "Discount 100 Yen"); [**claim 74**] the information corresponding to the location of the shelf in the business establishment comprises at least one of store (inherent), aisle (see Figure 2 "Rack No.", "Shell No.", and "Column No."; see paragraph bridging columns 4-5), and spacemap coordinate (see Figure 2, "Position Information"); [**claim 75**] the label includes a length substantially corresponding to a length of the shelf (see Figures 8A and 9; see column 8, lines 46-62); [**claim 76**] the information identified a plurality of products for display on the shelf, and wherein at least one space indicator is provided for each of the plurality of products (see column 2, lines 35-53; column 8, lines 46-62; see also Figure 9).

Regarding **claims 77-78**, Sekiguchi discloses a label (22; see Figure 1) for a display shelf (21) of a business establishment as set forth above in detail for claims 72-76.

Regarding **claim 93**, Sekiguchi discloses a method of stocking shelves (21, see Figures 1 and 9) for a business establishment as set forth above in detail for claims 72-76.

Regarding **claims 94-97**, Sekiguchi discloses a display shelf (21, see Figures 1 and 9) for a business establishment as set forth above in detail for claims 72-76.

Regarding **claims 99-114**, Sekiguchi discloses a graphic edge creation system for creating a shelf label for a business establishment as set forth above in detail for claims 72-76.

Regarding **claim 117**, Sekiguchi discloses a database (see Figure 2) for identifying and organizing products displayed by a business establishment as set forth above in detail for claims 72-76.

Regarding **claim 120**, Sekiguchi discloses a method for reducing labor for a business establishment as set forth above in detail for claims 72-76.

Regarding **claims 121-124**, Sekiguchi discloses a method for allocating products to display shelves of a business establishment as set forth above in detail for claims 72-76.

Regarding **claim 125**, Sekiguchi discloses a method for locating products for purchase in a business establishment using a computer system as set forth above in detail for claims 72-76.

8. Claims 92, 118, and 119 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,172,314 (hereinafter "Poland").

Regarding **claim 92**, Poland discloses a method for creating labels for product shelves comprising: printing a label for each shelf of a predetermined number of shelves of a business establishment, wherein information printed on each label identifies one or more products to be

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displayed on a respective shelf and wherein labels are printed based upon a price change of product included on a label (see column 5, line 55-column 6, line 59).

Regarding **claim 118 and 119**, Poland disclose a method for printing labels for product display shelves as set forth above in detail for claim 92.

9. Claim 126 is rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5,383,111 (hereinafter "Homma").

Regarding **claim 126**, Homma discloses a method for auditing products of display shelves of a business establishment (see column 5, lines 40-49) comprising: providing a plurality of display shelves with a label (see Figure 3B, "11c-11e), wherein the label (11c) includes a first machine readable code (bar code; see column 8, lines 49-66) for identifying the label; providing a handheld scanner ("handheld bar-code scanner", see column 12, lines 20-24) in communication with a database (see "Article Database 1600" in Figure 1; see also "Article Position Data File 7" in Figure 1) , wherein the database includes a first field containing the machine readable code (see column 8, lines 49-66) for a label and a second field containing the location of that label within a business establishment (see also "Article Position Data File 7" in Figure 1); scanning the first machine readable code of a first shelf label (see column 12, lines 20-24); and displaying, on the scanner, the information contained in the second field (see column 12, lines 20-24).

### ***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 79-91, 115, 116, and 132 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sekiguchi in view of Poland.

Regarding **claims 79-91, 115, 116, and 132**, Sekiguchi discloses all claim limitations as set forth above in paragraph 7, but fails to disclose printing labels in place of electronic labels.

Poland is relied upon for teaching updating prices labels that are either electronic or printed.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Sekiguchi with the printed labels taught by Poland, because printed labels are less costly to purchase than electronic labels.

12. Claims 127-131 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sekiguchi in view of U.S. Patent No. 5,388,158 (hereinafter "Berson").

Regarding **claims 127-131**, Sekiguchi discloses a database (see Figure 2) having a field for product location information, but fails to explicitly disclose a field related to an expiration date of the label.

Berson teaches a database containing an expiration date for a label (column 4, lines 38-48).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Sekiguchi with the expiration dates taught by Berson, because updating the labels allows the store to customize the labels for desired changes.

13. Claim 98 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sekiguchi in view of U.S. Patent No. 5,575,100 (hereinafter "Marvin").



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Regarding **claim 98**, Sekiguchi discloses all claim limitations as set forth above in paragraph 7, but fails to explicitly disclose a protective cover placed over a shelf strip.

Marvin is relied upon to teach the use of a protective cover placed over a shelf strip (see column 2, lines 10-11).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Sekiguchi with the protective cover taught by Marvin, because a protective cover reduces the chance of the label being damaged.

### *Conclusion*

14. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

Hunt, Revesz et al., and Failing et al. are cited of interest for disclosing electronic shelf labels.

Ramey is cited of interest for disclosing labels (68) defining a relative position of goods on display.

Marsh et al. is cited of interest for disclosing a shelf mountable printing apparatus that prints labels along the entire length of a shelf and clearly identifies the position of goods on a shelf (see arrow in Figure 3).

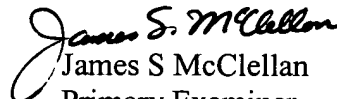
Gupta is cited of interest for disclosing a shelf price label verification apparatus including a price label scanner (10).

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15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James S. McClellan whose telephone number is (571) 272-6786. The examiner can normally be reached on M-F (9:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
James S McClellan  
Primary Examiner  
Art Unit 3627

jsm  
9/9/05